



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,249	08/01/2003	Joseph Dean Touch	28080-107	3302

7590 01/23/2008
MCDERMOTT, WILL & EMERY
Suite 3400
2049 Century Park East
Los Angeles, CA 90067

EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
----------	--------------

2145

MAIL DATE	DELIVERY MODE
-----------	---------------

01/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/632,249

Applicant(s)

TOUCH ET AL.

Examiner

MELVIN H. POLLACK

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Individual Patent Application
6) ☒ Other: see attached office action

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 29 October 2007 have been fully considered but they are not persuasive. An analysis of each argument is provided below.
2. The new title has been accepted, and the objection to the specification is withdrawn.
3. Applicant fails to define the term "relocated network subnet," and as such, the examiner is allowed to interpret the term as broadly as reasonable, based on the known ordinary definitions. Based on the fact that no claims establish moving any node or subnet, the examiner interprets the phrase merely to mean a set of nodes (i.e. a server farm) "removed" behind a firewall. In this light, claims 1 and 13 are seen as being drawn towards using a block of addresses to tunnel through a firewall, wherein the encapsulation protocol may be TCP/IP. A virtual private network, such as the one in Cheline, thus fulfills at least these claims.
4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "converting private addresses into public addresses (P. 6)") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, applicant concedes that this is but one application, and that the claims may therefore be interpreted in other ways.
5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the steps cannot be configured automatically (P. 7),") are not recited in the rejected claim(s). Although

the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. The rejections are maintained. This action is final.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-10, 13-19, 21, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Cheline et al. (7,197,550).
9. For claim 1, Cheline teaches a method (abstract) for relocating a network subnet to a remote location (col. 1, line 1 – col. 5, line 6; col. 18, line 58 – col. 19, line 11), comprising:
- a. Allocating a block of routable network addresses for use in a relocated network subnet at the remote location (col. 5, line 6 – col. 6, line 60; col. 7, lines 20-45; col. 13, lines 25-50);
 - b. Establishing a link from the network subnet to the relocated network subnet (col. 9, line 1 – col. 10, line 30); and
 - c. Configuring one or more services at the relocated network subnet (col. 9, line 1 – col. 10, line 30).
10. For claims 2, 14, Cheline teaches that the link comprises a tunnel(s) (col. 7, lines 45-65).

11. For claim 3, Cheline teaches that the routable network addresses comprise static IP addresses (col. 9, lines 60-65).
12. For claim 4, Cheline teaches that the routable network addresses are contiguous (col. 10, lines 15-25).
13. For claims 5, 18, Cheline teaches that the allocating a block of routable network addresses is performed by a lease broker (col. 6, line 6 – col. 6, line 60; col. 13, lines 20-50).
14. For claims 6, 16, Cheline teaches that the tunnel is configured to traverse a mechanism that encumbers communication (col. 6, line 60 – col. 8, line 50; col. 12, lines 10-20).
15. For claims 7, 17, 21, Cheline teaches that the mechanism that encumbers communication comprises a NAT (col. 6, line 60 – col. 8, line 50; col. 12, lines 10-20).
16. For claim 8, Cheline teaches that the one or more services comprises a routing configuration at the relocated network subnet for enabling communications over the tunnel (col. 8, lines 45-65).
17. For claim 9, Cheline teaches that the one or more services comprises a DNS server (col. 8, lines 45-65).
18. For claim 10, Cheline teaches that the one or more services comprises a DHCP server (col. 8, lines 45-65).
19. For claim 13, Cheline teaches a system (abstract) for subnet relocation (col. 1, line 1 – col. 5, line 6; col. 18, line 58 – col. 19, line 11), comprising:
 - a. an anchor router (Fig. 1, #112) coupled to a routable network (Fig. 1, #108);
 - b. a tether router (Fig. 1, #132) located remotely from the anchor router (Fig. 1, #116);

- c. a remote subnet coupled to the tether router (Fig. 1, #156), the subnet comprising a plurality of nodes (Fig. 1, #138-144), the nodes corresponding to a block of relocated routable network addresses (col. 5, line 6 – col. 6, line 60; col. 7, lines 20-45; col. 13, lines 25-50); and
 - d. a link between the anchor router and the tether router (col. 9, line 1 – col. 10, line 30).
20. For claim 15, Cheline teaches that the tunnel is configured to transmit packets comprising an encapsulation protocol (col. 7, lines 45-65).
21. For claim 19, Cheline teaches a computing apparatus for establishing a remote subnet, comprising:
- a. a tether router (Fig. 1, #132); and
 - b. a processor (Fig. 1, #136) configured to establish (col. 9, line 1 – col. 10, line 30) a tunnel from the tether router to an anchor router (col. 7, lines 45-65), wherein a block of routable addresses are allocated to a user, the block of addresses corresponding to the remote subnet, the tether router for relocating the remote subnet (col. 5, line 6 – col. 6, line 60; col. 7, lines 20-45; col. 13, lines 25-50).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cheline as applied to claim 1 above, and further in view of Spacey (2002/0038371).

24. For claim 11, (Original) The method of claim 1 wherein the one or more services comprises a mail server.

25. Claims 12, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheline as applied to claims 1 and 19 above, and further in view of Das et al. (6,992,994).

26. For claim 12 and 23, Cheline does not expressly disclose that the tunnel is configured to automatically reconnect in response to a change in an address associated with one of the components of the tunnel. Das teaches a method and system (abstract) of providing virtual private networks in mobile IP (col. 1, line 1 – col. 8, line 5; col. 12, lines 25-45), wherein a connection remains regardless of change in a home address (col. 9, lines 45-65). At the time the invention was made, one of ordinary skill in the art would have added Das to improve Cheline's telecommunications (DSL) networks (col. 5, lines 45-65).

27. For claim 24, Cheline discloses that a heartbeat signal is periodically emitted across the tunnel (col. 12, lines 40-50; col. 13, lines 30-35).

Conclusion

28. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELVIN H. POLLACK whose telephone number is (571)272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. H. P./
Examiner, Art Unit 2145
18 January 2008

Melvin H Pollack
Examiner
Art Unit 2145

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145